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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,918	07/03/2000	Goran E. Enhorning	ENG901US	3605

7590

06/18/2003

John C Thompson  
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Tonawanda, NY 14150

EXAMINER

CROSS, LATOYA I

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 06/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/609,918

Applicant(s)

ENHORNING, GORAN E.

Examiner

LaToya I. Cross

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3, 2003 has been entered.

### *Election/Restrictions*

2. Newly submitted claims 6 and 7 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 6 and 7 are directed to a method for delivering precise quantities of liquid samples. The device of claims 1-5 can be used in a materially different method, such as in photometrically evaluating samples as taught by Treptow.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 6 and 7 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Rejections - 35 USC § 103*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,844,686 to Treptow et al in view of US Patent 3,608,146 to Dunipace.

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Treptow et al '686 disclose a pipette apparatus. The pipette apparatus comprises a piston (suction) portion and a pipette tip portion as recited in claim 1. The piston portion controls the draw of liquid up into pipette tip or the releasing of the liquid (col. 2, lines 47-55). The pipette tip serves to absorb the liquid. At col. 2, lines 33-36 and col. 3, lines 16-20, Treptow et al teach that the pipette tip is made of inexpensive plastic material. Regarding the relationship between the piston portion and pipette tip portion, Treptow et al teach that the piston is provided with an accommodation (3) for receiving the pipette tip (4) therein. The accommodation (3) serves as a female member into which the pipette tip is disposed (col. 4, lines 44-51).

Treptow et al differ from the instantly claimed invention in that the reference does not explicitly state that the plastic used in making the pipette tip is "extruded".

Dunipace teaches a method for forming plastic pipettes. The method uses an extrusion process to transform plastic into disposable pipettes. Dunipace teaches that the extrusion method results in plastic pipettes having uniform dimensions.

It would have been obvious to one of ordinary skill in the art to use extruded plastic material in making the pipettes of Treptow to allow the pipettes to have uniformity.

Therefore, for the reasons set forth above, Applicants, claimed invention is deemed to be obvious over Treptow et al '686 in view of Dunipace.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treptow in view of Dunipace as applied to claim 1 above, and further in view of US Patent 5,468,453 to Holt et al.

The disclosure of Treptow et al '686 and Dunipace is given in detail above.

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Neither Treptow et al '686 nor Dunipace teach any particular plastic material for the pipette tip.

Holt et al '453 teach a pipette device having a pipette tip portion. The pipette tip is made of polytetrafluoroethylene plastic material (Teflon). See abstract and Col. 2, lines 43-54. The polytetrafluoroethylene is non-wettable (hydrophobic). It would have been obvious to one of ordinary skill in the art to use a teflon material, such as disclosed by Holt et al '453 to make the pipette tip of Treptow et al '686 because Holt et al '453 teach that Teflon inhibits fluid adhesion to the tube, thereby assuring a precise amount of liquid is taken up by the pipette.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious in view of Treptow et al '686 and Dunipace in view of Holt et al '453.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treptow et al and Holt et al as applied to claims 2 and 3 above, and further in view of US Patent 4,362,063 to Marteau d'Autry.

The disclosure of Treptow et al '686, Dunipace '146 and Holt et al '453 is described above. Neither Treptow nor Holt teach a piston cylinder having a piston slidable within the piston cylinder. Treptow teaches a piston portion (1), but no slidable piston is disclosed within it.

Marteau d'Autry teaches a pipette for sampling and dispensing volumes of liquid sample. The pipette of Marteau d'Autry contains a capillary tube (24) having a slidably fitted piston (14) within it. A control rod (20) controls the movement of the piston within the tube. The capillary tube is equivalent to Applicants' piston cylinder. The piston is in the form of a stainless steel wire. The pipette having a tube capable of fitting a piston and a control means

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allows the pipette to be of shorter length and thus, provides easier handling by users and allows easier accommodation when used with automatic devices.

It would have been obvious to one of ordinary skill in the art to incorporate a slidable piston member within the piston of Treptow to decrease the overall length of the pipette and make the device easier to handle and better for use with automatic devices.


Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103 in view of the teachings of Treptow, Dunipace Holt and Marteau d'Autry.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 703-305-7360. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

lic  
June 16, 2003

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700